



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/430,906 11/01/99 WEST

J PW-1

BENCEN & VAN DYKE PA
1630 HILLCREST STREET
ORLANDO FL 32803

IM22/0828

EXAMINER

SHERRER, C

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

08/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/430,906

Applicant(s)

West et al

Examiner

Curtis E. Sherrer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 12, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) 18-20, 25-27, 31, 32, and 34-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 21-24, 28-30, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Part III DETAILED ACTION

Election/Restriction

1. Claims 18-20, 25-27, 31, 32 and 34-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6 and 8. Applicants elected to prosecute claims directed to aqueously soluble, garnish shaped and gelatin based. The claims that cover these species are 1-17, 21-24, 28-30 and 33.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17, 21-24, 28-30 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 1-17, 21-24, 28-30 and 33 are indefinite because the scope of the phrases "sufficient quantity of an ethanol composition to facilitate transport, storage, delivery and consumption" and "recreationally relevant" is not known.

5. Claims 2-4 are indefinite because the scope of the phrase “easily transportable” is not known.
6. Claim 4 is indefinite because the scope of the phrase “easily rupturable” is not known.
7. Claim 5 is indefinite because the scope of the phrase “similarly shaped” is not known.
8. Claim 6 is indefinite because the scope of the phrase “approximately” is not known.
9. Claim 7 is indefinite because the scope of the phrases “such. as” and “and the like” is not known.
10. Claims 8-12 are indefinite because the scope of the phrase “about” is not known.
11. Claim 13 is indefinite because it is not seen how the limitation of using a “nontoxic substance” is not inherently contained in the main claim, which requires the capsule to be non-toxic. In other words, it is not seen how claim 13 further limits claim 1.
12. Claim 15 is indefinite because the scope of the phrases “optionally” and “easy swallowing” is not known.
13. Claim 17 is indefinite because the scope of the phrase “sufficiently small to permit easy passage” is not known.
14. Claim 21 is indefinite because the scope of the phrase “various concentrations” is not known.
15. Claim 28 is indefinite because the scope of the phrase “appearance of a garnish” is not known.

16. Claim 29 is indefinite because the scope of the phrase "appearance of an olive" is not known.

17. Claim 30 is indefinite because the scope of the phrase it appears that the concentration of alcohol is linked to the dissolution of the outer coating and it is unclear how what is sealed inside the capsule can affect the dissolution of the capsule.

18. Claim 31 is indefinite because the scope of the phrases "about" "optionally and "substantially" is not known.

19. Claim 33 is indefinite because there is no antecedent basis for "alcoholic beverage.".

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

21. Claims 1-5, 7-10, 13-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Brox (U.S. Pat. No. 4,888,239).

22. Brox teaches the production of gelatin capsule that contains about 5-50% ethanol. (Abstract). The capsule's shell may contain colorants, preservatives, flavoring agents, sugar and other polyols." (Col. 2, lines 65-66).

Claim Rejections - 35 USC § 102/103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claims 1-5, 7-17 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as being unpatentable over Sanker et al. (U.S. Pat. No. 5,620,707)(hereinafter Sanker) in light of Handbook of Perfumes and Flavors, page 280)..

25. Sanker teaches the of gelatin flavor beads that can be spheres, oblong shapes, disks, puffed squares and cylinders. If spherical, they range to about 15 mm. (Col. 2, lines 25-33). The beads can contain flavoring such as the various flavors recited in col. 2, lines 48-62, so as to be used to flavor drinks. (Col. 4, lines 20-46). The flavoring can amount to about 0.4 ml (from 400 mg) and this would then amount to about 0.4 ml of ethanol.

26. It is noted that it is notoriously well known that these flavor formulations can inherently contain around 90% of 95% ethanol. See Handbook of Perfumes and Flavors, page 280, where Brandy (Cognac) No. 2 contains 89.2% of 95% ethanol. Therefore, while it is considered that Sanker does not specifically teach the inclusion of alcohol, the recite flavors inherently contain large amounts of ethanol. Further it would have been obvious to those of ordinary skill in the art

to use ethanol as the flavor carrier as it is a notoriously well known flavor carrier for its solubility characteristic.

27. Finally, Applicants' attention is invited to *In re Levin*, 84 U.S.P.Q. 232 and the cases cited therein, which are considered in point in the fact situation of the instant case, and wherein the Court stated on page 234 as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients which produces a new, unexpected, and useful function. *In re Benjamin D. White*, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 U.S.P.Q. 267; *In re Mason et al.*, 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 U.S.P.Q. 221.

Claim Rejections - 35 USC § 103

28. Claims 6 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker.

29. Sanker teaches that cited above but does not teach the production of capsules the size or appearance as claimed. While Sanker recites using colorings and various shapes and no specific mention is made of imitating a garnish or olive, it would have been obvious to those of ordinary skill in the art to modify the product of Sanker so as to appear to be a garnish as he teaches the production of oblong shapes.

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30. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanker in view of McMahon et al (U.S. Pat. No. 5,466,460).

31. Sanker teaches that cited above, but they does not mention the use of a cross-linked gelatin using glutaraldehyde. While the use of such a capsulant is notoriously well known in the capsule art, the following reference is cited to teach its well known use. McMahon et al teach the production of a capsule whose capsule wall comprises a glutaraldehyde cross linked gelatin. (Col. 4, lines 15-22). It would have ben obvious to those of ordinary skill in the art to use the capsule wall composition of McMahon et al in the product of Sanker because it is a notoriously well known capsule wall composition.

Conclusion

32. No claim is allowed.

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Curtis Sherrer whose telephone number is (703) 308-3847. The examiner can normally be reached on Tuesday through Friday from 6:30 to 4:30. The **fax phone number** for this Group is (703)-305-3602.

34. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.



Curtis E. Sherrer
Primary Examiner
August 24, 2001